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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/777,246	12/31/1996	KAZUOMI OISHI	35.G1868	3060
5514	7590	01/13/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			SONG, HOSUK	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2135	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/777,246

Applicant(s)

OISHI, KAZUOMI

Examiner

Hosuk Song

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34, 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2004 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 34,36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brachtl et al.(US 4,908,861) in view of Mollier et al.(US 4,656,474).

Claims 34,36: Brachtl's patent disclose first input means for inputting data from an internal unit in (fig.2,message m and fig.5). Brachtl discloses a second input means inputting secret key information from an external device in (fig.2,5,secret key). Brachtl discloses generating a digital signature using data and secret key information in (fig.1,MAC or digital signature). Brachtl discloses outputting digital signature to external device in (fig.2,data sent and data received). Brachtl does not specifically disclose external device is portable. Mollier's patent disclose digital signature method where external portable device containing secret key in (col.3,lines 15-17;col.4,lines 35-39). It

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would have been obvious to person of ordinary skill in the art at the time invention was made to employ portable external device as taught in Mollier with cryptographic device disclosed in Brachtl because portability allows user to conveniently transport its key from one device to another device when threat is detected thus securely protecting its key where key is not bound to fixed location thus minimizing random or continuous attacks.

Claim 37: Brachtl and Mollier disclose all the limitations. It is inherent in system of Brachtl to include some type of software or program code to carry out such function as generating a digital signature and process key information.

Claim 38: Brachtl's patent disclose first input means for inputting data from an internal unit in (fig.2,5,message m). Brachtl discloses a second input means inputting secret key information from an external device in (fig.2,secret key). Brachtl discloses generating a digital signature using data and secret key information in (fig.1,MAC or digital signature). Brachtl discloses outputting digital signature to external device in (fig.2,data sent and data received). Brachtl does not specifically disclose external device is portable device. Mollier's patent disclose digital signature method where external portable device containing secret key in (col.3,lines 15-17;col.4,lines 35-39). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ portable external device as taught in Mollier with cryptographic device disclosed in Brachtl because portability allows user to conveniently transport its key from one device to another device when threat is detected thus securely protecting its key where key is not bound to fixed location thus minimizing random or continuous attacks.

Claim 39: Brachtl's patent disclose first input means for inputting data from an internal unit in (fig.2,5,message m). Brachtl discloses a second input means inputting secret key information from an external device in (fig.2,secret key). Brachtl discloses compressor means for compressing data in (fig.2). Brachtl discloses generating a digital

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signature using data and secret key information in (fig.1,MAC or digital signature). Brachtl discloses outputting digital signature to external device in (fig.2,data sent and data received). Brachtl does not specifically disclose external device is portable device. Mollier's patent disclose digital signature method where external portable device containing secret key in (col.3,lines 15-17;col.4,lines 35-39). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ portable external device as taught in Mollier with cryptographic device disclosed in Brachtl because portability allows user to conveniently transport its key from one device to another device when threat is detected thus securely protecting its key where key is not bound to fixed location thus minimizing random or continuous attacks.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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